

REMARKS

Applicant hereby cancels claims 4 and 35 without prejudice or disclaimer, and amends claims 1, 5-9, 17, 24, 26, 30, 31, 36, 37, 39, and 40. Claims 1-3, 5-34, and 36-48 remain pending in the application with claims 1, 26, 39, and 40 being in independent form. The rejection of claims 4 and 35 is rendered moot by their cancellation.

In the Office Action mailed January 4, 2010,¹ the Examiner rejected claims 1-3, 18-23, 25-31, and 36-42 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0200610 A1 to Skantze et al. ("Skantze"), and rejected claims 4-17, 24, 32-35, and 43-48 under 35 U.S.C. § 103(a) as being unpatentable over Skantze in view of U.S. Patent Application Publication No. 2003/0094492 A1 to Kia et al. ("Kia").

I. Rejection of Claims 1-3, 18-23, 25-31, and 36-42 under 35 U.S.C. § 102(e)

In order to properly establish that Skantze anticipates Applicant's claims under 35 U.S.C. § 102, each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131., 8th Ed., Rev. 7 (July, 2008). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)).

With regard to amended claim 1, Skantze fails to disclose or suggest, among other steps, "selectively changing, from the allotted state to a released state, the state

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

indicator of at least one pattern unit whose state indicator is set to the allotted state," as recited in amended claim 1.

On page 9 of the Office Action, the Examiner concedes that *Skantze* "does not suggest changing the state indictor from the allotted state to a released state." Applicant agrees and submits that *Skantze* fails to disclose or suggest each and every feature of amended claim 1. Thus, independent claim 1 is allowable over *Skantze*. Amended independent claims 26 and 39, while of different scope than claim 1, distinguish over *Skantze* for at least similar reasons as claim 1. Claims 2, 3, 18-23, 25, 27-31, and 36-38 depend from one of claims 1 and 26. Accordingly, *Skantze* also fails to disclose the subject matter of claims 2, 3, 18-23, 25, 27-31, and 36-38.

With regard to amended claim 40, *Skantze* fails to disclose or suggest, among other steps, "controlling the flow of data, from the electronic pen to said one of the plurality of destination units, at least partly **based on the state indicator**," (emphasis added) as recited in amended claim 40.

On page 8 of the Office Action, the Examiner alleges that paragraph [0036] of *Skantze* allegedly discloses "controlling the flow of data . . . at least partly based on the state indicator," as recited in amended claim 40. This, however, is not correct at least because paragraph [0036] of *Skantze* actually discloses processing performed by browser program 22 based on assignment data CODE, when position code is allocated, but does not teach or suggest "controlling the flow of data, from the electronic pen to said one of the plurality of destination units, at least partly based on the state indicator," (emphasis added) as recited in claim 40. There is no disclosure in *Skantze* of

controlling the flow of data from an electronic pen to a destination unit based on a state indicator.

Thus, *Skantze* fails to disclose or suggest each and every feature of amended claim 40, and independent claim 40 is allowable over *Skantze*. Claims 41 and 42 depend from claim 40. Accordingly, *Skantze* also fails to disclose the subject matter of claims 41 and 42.

Accordingly, *Skantze* also fails to disclose the subject matter of claims 1 1-3, 18-23, 25-31, and 36-42; and Applicant respectfully requests the withdrawal of the 35 U.S.C § 102(e) rejection of these claims.

II. Rejection of Claims 4-17, 24, 32-35, and 43-48 under 35 U.S.C. § 103(a)

The rejection of claims 4 and 35 under 35 U.S.C. § 103(a) has been rendered moot by the cancellation of these claims. To the extent the rejection of these claims is relevant to amended claims 1, 26, and 39, the remarks below are equally applicable to claims 1, 26, and 39.

Applicant respectfully traverses the rejection of claims 5-17, 24, 32-34, and 43-48 under 35 U.S.C. § 103(a) because *Skantze* cannot be relied upon as prior art to support the 35 U.S.C. § 103(a) rejection.

35 U.S.C. § 103(c)(1) states that:

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, **shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.** (Emphasis added).

Applicant's application was filed on May 4, 2006 and claims priority from: PCT/SE04/01665, filed on November 16, 2004; Provisional Application No. 60/520,642, filed on November 18, 2003; and Swedish Patent Application No. 0303058-2, filed on November 18, 2003. In view of these applications, the effective priority date of Applicants' application is November 18, 2003.

Skantze was published on September 15, 2005, which is after Applicant's priority date of November 18, 2003. Accordingly, *Skantze* does not qualify as prior art against Applicant's application under 35 U.S.C. §§ 102(a) or (b).

Skantze appears to qualify only under 35 U.S.C. § 102(e). Further, *Skantze* was commonly owned with the instant application by the same person or was subject to an obligation of assignment to the same person at the time of Applicant's application. See e.g., *Skantze* assignment recordation, Reel/Frame Nos. 016386/0721, 017526/0199, and 017964/0148 and instant application assignment recordation, Reel/Frame No. 020078/0498. A record of these assignments is enclosed. Thus, pursuant to 35 U.S.C. § 103(c), *Skantze* cannot be relied upon to reject claims 5-17, 24, 32-34, and 43-48 under 35 U.S.C. § 103(a). Moreover, *Kia* does not render obvious each and every feature of the claims.

Accordingly, for at least the reasons noted above, the 35 U.S.C. § 103(a) rejection of claims 5-17, 24, 32-34, and 43-48 is improper and should be withdrawn.

III. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 4, 2010

By: 

Elizabeth M. Burke
Reg. No. 38,758
(202) 408-4000

Philip J. Hoffmann
Registration No. 46,340

Attachments to this Amendment include:

USPTO Assignment record of U.S. Patent Application No. 10/578,253; and

USPTO Assignment record of U.S. Patent Application No. 10/516,594.